

REMARKS:

Claims 1-32 are in the case and presented for consideration.

Applicants reaffirm their election of claims 1-13 and 20-31. Claims 14-19 have been retained and amended however to depend either directly or indirectly from method claim 1 and thus further limit the method by defining an apparatus or system for practicing the method. Since only the claimed method can be practiced, the restriction requirement is traversed to the extent that claims 14-19 should be considered.

Turning to the Examiner's comments concerning the Information Disclosure Statement, after investigation it could not be determined how the Ormand reference, "Does Your Liquid Handler Pipet Accurately ?", came to be in the possession of the assignee company or the inventors. To the best of the Applicant's knowledge the paper was published in November of 1998 since it memorialized an ISLAR (International Symposium Laboratory Automation and Robotics) conference that took place between October 18, and October 21, 1998, with the conference proceedings having been published in November 1998.

The inventors have reviewed the Ormand reference and the claims presented here are believed to be patentably distinct over this reference in that the claims define an automated process that uses statistical methodologies to solve the problem of obtaining ideal liquid-handling results whereas the Ormand reference merely describes how some of these same methodologies can be applied to a portion of the problem. The reference does not disclose or suggest an automated process of experimentation nor does it teach or suggest the additional steps of the claimed invention.

The Examiner has also rejected claims 1-3, 7 and 11 as being indefinite under 35 U.S.C. 112.

Specifically the Examiner inquires whether the steps of the method are performed by a fully automated device.

The claimed invention takes a selection of parameters with suspected influence over pipetting precision and automates the process of performing a "screening" experiment to determine which of the input parameters have a possible affect. The result of that experiment is then the input of the experiment which optimizes the levels of these screened parameters. The only manual portion of the method is the selection of which parameters to include in the initial screening experiment. This manual step has been identified in amended claim 1 as "user-selected parameters and levels." The remainder of the method is automated.

In claims 2, 3, 7, and 11 which depend from claim 1, define steps that can be formed in various sequences so that the specific order of the steps is not meant to be a limitation of the invention.

The claims are now therefore believed to be in proper form under 35 U.S.C. 112.

The Examiner has also rejected claims 1-7, 11, 13, 20, 26, 30 and 32 as being fully anticipated by U.S. Patent 5,998,218 to Conley, et al.

Applicant also gratefully acknowledge the Examiner's indication of allowability for claims 8-10, 12, 27-29, and 31.

Claims 1 and 20, the only independent claims presented, have both been amended to incorporate the initial important step of claim 8 but have not been amended to include all of the limitations of claim 8. Despite this, however, it is believed that newly presented claims 1 and 20 are novel and unobvious over Conley.

Conely does not disclose the generation of a screening experimental design based on user-selected parameters and levels in order to determine a plurality of factors that can

be eliminated from any additional evaluation. This is believed to be a significant and unobvious departure from the teaching of Conley and from the teaching of the Prior Art as a whole are therefore all of the claims are believed to be patentably distinguish over the Prior Art and to be in condition for allowance.

The remaining claims distinguish the invention further from the Prior Art and are likewise believed to be in condition for allowance.

Attached to this amendment also please find a further Revocation and Power of Attorney and a further request that all future correspondence for this application be addressed as follows:

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For extra measure a separate Change of Address Request is also made with this amendment.

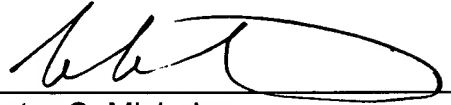
The Examiner's also respectfully invited to telephone me the undersigned if any matters remain which can be treated by telephone interview in the interest reaching a conclusion to the prosecution of this case.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

Favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter C. Michalos', written over a horizontal line.

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Dated: October 29, 2004

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